

ESTTA Tracking number: **ESTTA280764**

Filing date: **04/28/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91186018
Party	Plaintiff In-N-Out Burgers
Correspondence Address	Edward O. Ansell Law Office of Edward O. Ansell 427 N. Yale Avenue, Suite 204 Claremont, CA 91711 UNITED STATES anselaw@verizon.net
Submission	Motion for Summary Judgment
Filer's Name	Edward O. Ansell
Filer's e-mail	anselaw@verizon.net
Signature	/Edward O. Ansell/
Date	04/28/2009
Attachments	quagliasummaryjudge.01.pdf (13 pages)(178285 bytes) Quagliagamedeceoa.01.pdf (2 pages)(110954 bytes) quagliasummaryexA.pdf (3 pages)(974555 bytes) quagliasummaryexBpdf.pdf (2 pages)(618582 bytes) quagliasummaryexC.pdf (2 pages)(691003 bytes) quagliasummaryexD.pdf (5 pages)(1494634 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

IN THE MATTER OF APPLICATION SERIAL NO. 76/687,302
FOR THE MARK “IN & OUT”
PUBLISHED IN THE OFFICIAL GAZETTE OF July 22, 2008

In-N-Out Burgers)	
Opposer)	
)	
v.)	OPPOSITION NO. 91186018
)	
Brian Quaglia and Sandra Quaglia)	
Applicants)	
_____)	

**OPPOSER’S MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION AND MOTION
FOR SUMMARY JUDGMENT**

TABLE OF CONTENT

Opposer’s Motion For Leave To Amend Notice Of Opposition and Motion For Summary Judgment.....	1
Memorandum In Support Of Opposer’s Motion For Leave To Amend Notice Of Opposition	2
Memorandum In Support Of Opposer’s Motion For Summary Judgment	4
I. Introduction.....	4
II. Argument.....	4

TABLE OF AUTHORITIES

Cases

<i>Celotex Corp. v. Catrett</i> , 477 U.S. 317, 324-25 (1986).....	4
<i>General Car and Truck Leasing Systems Inc. v. General Rent-A-Car Inc.</i> 17 USPQ 1398 (S.D. Fla 1990).....	6
<i>Hurley International LLC v. Volta</i> , 82 USPQ 2d 1339 (TTAB 2007).....	6
<i>Matsushita Elec. Indus. Co. v. Zenith Radio Corp.</i> , 475 U.S. 574, 587 (1986).....	4
<i>Medinol Ltd. v. Neuro VASX Inc.</i> , 67 USPQ2d 1205 (TTAB 2003).....	4, 5, 6
<i>Pure Gold. Inc. v. Syntex (U.S.A.). Inc.</i> , 222 U.S.P.Q. 741, 743 (Fed. Cir. 1984).....	4
<i>Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha</i> , 77 USPQ 1917 (TTAB 2006).....	6
<i>Sweats Fashions. Inc. v. Pannill Knitting Co.</i> , 833 F.2d 1560, 4 U.S.P.Q.2d 1793, 1797 (Fed. Cir. 1987).....	5
<i>Torres V. Cantine Torresella S.r.l</i> , 808 F.2d 46, 1 U.S.P.Q.2d 1483 (Fed. Cir. 1986).....	6

Statutes

Section 1(a) of the Trademark Act.....	2
--	---

Rules

Trademark Rule 2.107(a).....	2
Trademark Rule 2.120(a)(2).....	2
Federal Rules of Civil Procedure 15(a).....	1, 2
Federal Rules of Civil Procedure 56.....	5
Federal Rules of Civil Procedure 56(c).....	1, 4
T.B.M.P § 507.....	2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

IN THE MATTER OF APPLICATION SERIAL NO. 76/687,302
FOR THE MARK “IN & OUT”
PUBLISHED IN THE OFFICIAL GAZETTE OF July 22, 2008

In-N-Out Burgers)	
Opposer)	
)	
v.)	OPPOSITION NO. 91186018
)	
Brian Quaglia and Sandra Quaglia)	
Applicants)	
)	

Commissioner for Trademarks
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

**OPPOSER’S MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION AND MOTION
FOR SUMMARY JUDGMENT**

To the TTAB:

Opposer, In-N-Out Burgers (“Opposer”) hereby moves the Trademark Trial and Appeal Board (the “Board”) for leave to amend its Notice of Opposition under Federal Rules of Civil Procedure 15(a) to add a cause of action for fraud, and moves the Board for summary judgment under Federal Rules of Civil Procedure 56(c), granting its opposition to U.S. Trademark Application No. 76/687,302.

Opposer’s Motion is supported by the Declaration of Edward O. Ansell attached hereto (“Ansell Decl.”) and the Exhibits A, B and C, attached to the Ansell Decl. Additionally, a First Amended Notice of Opposition is being submitted concurrently herewith as Exhibit D.

**MEMORANDUM IN SUPPORT OF OPPOSER'S MOTION FOR LEAVE TO AMEND NOTICE
OF OPPOSITION**

Pursuant to Federal Rules of Civil Procedure 15(a), Trademark Rule 2.107(a) and T.B.M.P § 507, Opposer hereby requests that the Board grant Opposer leave to amend its Notice of Opposition.

Brian and Sandra Quaglia's (Applicant's) application at issue in this opposition proceeding, U.S. Trademark Application Serial No. 76/687,302, filed on March 3, 2008 for the Mark "IN & OUT" identifies the goods in International Class 028 as a "Game, namely, a dice game." Applicant's sole basis for registration for the goods in 028 is Applicant's actual use of the mark in U.S. commerce under Section 1(a) of the Trademark Act.

The facts concerning Applicant's fraud in filing and prosecuting Applicant's application have only recently come to light and are set forth more fully in the Ansell Declaration. As set forth in the schedule at page 7 of the Board Order of March 13, on Friday, April 10, 2009, counsel for Opposer telephoned Applicant Brian Quaglia for the mandatory discovery conference, the deadline for which was April 11. Mr. Quaglia professed ignorance of the requirement, and counsel for Opposer volunteered to provide Mr. Quaglia with explanatory material, including a copy of Trademark Rule 2.120(a)(2), which was sent on April 10.

Inasmuch as Opposer's counsel had indicated a desire to continue the conference on the 13th, Mr. Quaglia sent an email response on April 12 to forestall said conference, indicating that Applicants' goods had never been produced and "IT HAS NEVER BEEN MADE. IT WAS ONLY AN IDEA A LONG TIME AGO."

Counsel for Opposer responded, advising Mr. Quaglia that if he and Sandra Quaglia did not wish to proceed, he should advise counsel for Opposer. Nothing further has been heard from Applicants. Opposer seeks leave to amend its Notice of Opposition to add a cause of action for fraud. Applicants admit that they have not used at the time of Applicant's application, and have never used, Applicants' mark in U.S. commerce in connection with the goods listed in Applicants' Application.

These are material misrepresentations of fact that Applicants knew or should have known were false or misleading. Thus, Opposer requests leave to amend its Notice of Opposition to properly reflect the charge of fraud based on this evidence recently obtained during discovery.

Section 507.02 of the Trademark Trial and Appeal Board Manual of Procedure states that once the answer to the pleading has been filed, a party may amend its pleading only by written consent of every adverse party or by leave of the Board; leave must be freely given when justice so requires if it will

not unduly prejudice the adverse party. Opposer respectfully submits that acceptance of the First Amended Notice of Opposition does not prejudice Applicant. All evidence relevant to the claim of fraud that may benefit Applicant is already in the Applicant's possession and control. In light of the foregoing, justice requires the Board to grant leave to Opposer to Amend its Notice of Opposition to plead this cause of action.

MEMORANDUM IN SUPPORT OF
OPPOSER'S MOTION FOR SUMMARY JUDGEMENT

I. INTRODUCTION

Opposer has brought the subject Opposition proceeding against the Application, owned by Applicants, as Opposer believes that it will be damaged by the registration of the Application. As set forth more fully in the memorandum herein and exhibits attached hereto, this motion is made on the ground that Applicants have committed fraud in attempting to procure a registration for Applicants' Mark, thus making Applicants' application *void ab initio*. Specifically, at the time of filing Applicants' application and during the prosecution of Applicants' application, Applicants made material representations of fact that Applicants knew or should have known were false and/or misleading. The undisputed facts have been set forth in the preceding memorandum in support of Opposer's Motion for Leave to Amend the Notice of Opposition, Ansell's Declaration and the Exhibits attached thereto. Accordingly, Opposer requests that the Board deny registration of Applicant's application in light of the fraud committed by Applicant in filing and prosecuting the application.

II. ARGUMENT

Summary judgment should be granted where it is shown that there is no genuine issue of material fact, and the moving party is entitled to judgment as a matter of law. See Federal Rules of Civil Procedure 56(c); see also *Medinol Ltd. v. Neuro VASX Inc.*, 67 USPQ2d 1205 (TTAB 2003). As the Federal Circuit stated in *Pure Gold, Inc. v. Syntex (U.S.A.). Inc.*, 222 U.S.P.Q. 741, 743 (Fed. Cir. 1984):

The basic purpose of summary judgment procedure is one of judicial economy -- to save the time and expense of a full trial when it is unnecessary because the essential facts necessary to decision of the issue can be adequately developed by less costly procedures, as contemplated by the FRCP rules here involved, with a net benefit to society.

As the moving party, Opposer has the burden of demonstrating that it is entitled to summary judgment. See *Celotex Corp. v. Catrett*, 477 U.S. 317, 324-25 (1986). If Opposer meets its burden of identifying undisputed facts entitling it to relief, Applicant must submit specific facts showing that there is a genuine issue for trial. *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 587 (1986).

These general principles of summary judgment apply under Federal Rule of Civil Procedure 56 to *inter-partes* proceedings before the Board. See e.g., *Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 U.S.P.Q.2d 1793, 1797 (Fed. Cir. 1987).

In the instant case, Opposer contends that Applicants, both at the time they filed the application, and to date, were not and are not using Applicants' Mark in commerce in connection with the goods listed in the application.

Thus, the application is invalid, because Applicant Brian Quaglia falsely signed and filed the original application oath for its application, based solely on Section 1(a) of the Trademark Act, when Applicant Brian Quaglia knew, or should have known, that he was not using Applicants' Mark within the meaning of the Trademark Act, on the goods identified in the application in U.S. commerce.

The facts in the present case are similar to those in *Medinol Ltd. ("Medinol")*, *supra*. In that case, the registrant submitted a Statement of Use which included an allegation of use on certain goods, which registrant later admitted it was not using with its mark in the United States at the time of filing the Statement of Use. The false statements in the Statement of Use by the owner of the mark were then relied upon by the United States Patent and Trademark Office in determining the applicant's rights to the registration.

Like *Medinol*, in the present case, Applicant Quaglia submitted under oath the application, which included an allegation of use on certain goods, which Applicants have admitted they were not using with the mark in the United States at the time of filing the application, and for that matter, have never used its mark in connection with the identified goods in the United States. The facts and circumstances of the subject case and the *Medinol* case are virtually identical, except that here, Applicant submitted false evidence and statements as to the use of its mark in United States commerce in connection with the identified goods *at the time of filing the Application*, rather than at a later point in the prosecution by means of a Statement of Use, as in *Medinol*. Both relate to the same issue: false statements alleging use in commerce of the relevant mark in connection with all of the goods or services in the relevant application.

Similar to the facts of *Medinol*, in the instant case, Applicants have admitted that as of the filing date of the application, they were not using the mark in connection with the goods identified in the application with its mark in United States commerce. (See Ansell Decl. Exhibit B)

Thus, in both *Medinol* and the case at hand, a material misrepresentation of fact with regard to the use of the mark on particular goods/services was made by an owner of the mark and that statement was relied upon by the PTO in determining the applicant's rights to the registration. In this case, as in *Medinol*, the material misrepresentation of fact was made in a declaration signed by an owner of the mark and submitted to the United States Patent and Trademark Office.

Opposer notes that the intent element of fraud has clearly been met in this case and occurs "when an applicant or registrant makes a false material representation that the applicant or registrant knew or should have known was false." See *Torres V. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 U.S.P.Q.2d 1483 (Fed. Cir. 1986); see also *Medinol Ltd. v. Neuro VASX Inc.*, 67 USPQ2d 1205 (TTAB 2003). Accord: *Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ 1917 (TTAB 2006); *Hurley International LLC v. Volta*, 82 USPQ 2d 1339 (TTAB 2007). In *Medinol*, the Board considered the question of the intent of the individual making the false representation of fact, holding that it is not registrant's subjective intent that is significant but instead the objective manifestations of that intent, citing *General Car and Truck Leasing Systems Inc. v. General Rent-A-Car Inc.* 17 U.S.P.Q. 1398, at 1400 (S.D. Fla. 1990) "... proof of specific intent to commit fraud is not required, rather fraud occurs when an applicant or registrant makes a false material representation that the applicant or registrant knew or should have known was false."

Based on the record, there is no genuine issue of material fact that Applicant Brian Quaglia filed an application based on actual use of the mark in U.S. commerce and signed a declaration attesting to the truth of all statements in the application, when he knew, or should have known, he had not used Applicants' Mark in connection with the goods listed in the application.

In view of the foregoing, it is clear and undisputed that Applicant Brian Quaglia has made misrepresentations of facts which he knew or should have known to be false and/or misleading in the

application. Hence, there are no genuine issues of material fact in connection with this motion, and the Board should find that Applicants have committed fraud in procuring a registration by filing false statements in the application. Consequently, Application No. 76/687,302 is void and should not be allowed to proceed to registration.

WHEREFORE, Opposer moves the Board for leave to Amend the Notice of Opposition, to grant Opposer's Motion for Summary Judgment, Sustaining the Opposition, Denial of Registration of Applicants' Mark, or such other judgment as it deems appropriate.

Respectfully submitted,

/Edward O. Ansell/

Edward O. Ansell
Attorney for Opposer
In-N-Out Burgers

Date: April 28, 2009
427 N. Yale Ave.
Suite 204
Claremont, CA 91711
Tel: (909) 621-1985
Fax: (909) 624-1664
Email: anselaw@verizon.net

PROOF OF SERVICE:

I hereby certify that on April 28, 2009 a copy of the foregoing Opposer's Motion For Leave To Amend Notice Of Opposition And Motion For Summary Judgment was deposited with the U.S. Postal Service, first class mail postage prepaid, to the Applicant, Brian Quaglia, 151 Airport Rd., Warwick, RI 02886.

_____/Edward O. Ansell/
Edward O. Ansell

PROOF OF SERVICE:

I hereby certify that on April 28, 2009, a copy of the foregoing Opposer's Motion For Leave To Amend Notice Of Opposition And Motion For Summary Judgment was deposited with deposited with the U.S. Postal Service, first class mail postage prepaid, to the Assignee Sandra Quaglia, 77 Peck Street, Rehoboth, MA 02769-2806

_____/Edward O. Ansell/
Edward O. Ansell

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

IN THE MATTER OF APPLICATION SERIAL NO. 76/687,302
FOR THE MARK "IN & OUT"
PUBLISHED IN THE OFFICIAL GAZETTE OF July 22, 2008

In-N-Out Burgers)	
Opposer)	
)	
v.)	OPPOSITION NO. 91186018
)	
Brian Quaglia and Sandra Quaglia)	
Applicants)	
_____)	

DECLARATION OF EDWARD O. ANSELL

I, EDWARD O. ANSELL do hereby declare and state:

1. I am a citizen of the United States, a member of the bar of the United States District Court in the Central District of California, and a resident of the County of Los Angeles in the State of California. I am attorney of record for Petitioner/Opposer in the above entitled action, and my business address for this Opposition is 427 N. Yale Avenue, Suite 204, Claremont, CA 91711
2. On Friday, April 10, 2009, I telephone Brian Quaglia at (401)421-7622. Mr. Quaglia answered the telephone and I identified myself, stating that the purpose of my call was to conduct the mandatory discovery conference, the deadline for which was April 11, 2009.
3. Mr. Quaglia responded by saying: "I don't know what you are talking about."
4. I offered to send him an explanatory email, a copy of which is attached as Exhibit A.
5. On Sunday, April 12, I received an email (attached as Exhibit B) from Mr. Quaglia stating:
"I was told that we had sbmitted (sic) a letter to you some time ago saying we are not

arguing the POINT; THIS ITEM WE ARE NOT EVEN PROCEEDING WITH AND HAVE NOT PRODUCED ANYTHING ... ITS A DICE GAME, AND IT HAS NEVER BEEN MADE IT WAS ONLY AN IDEA A LONG TIME AGO.”

6. I replied to Mr. Quaglia by email, advising that I had received no such letter and that if Brian and Sandra Quaglia did not wish to proceed it would be necessary to be so advised by both of them. I asked that I be informed of their joint wishes ASAP (See Exhibit C).
7. I have received no communication from Applicants as of the date of this Declaration.
8. These motions are made in good faith and not filed for any improper purpose, the legal contentions contained in the motions are warranted by existing law, and all factual contentions made by declarant in the motions and memorandum are supported by evidence.
9. I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct.

Respectfully submitted

/Edward O. Ansell/

Edward O. Ansell
Attorney for Petitioner/Opposer
In-N-Out Burgers

Date: April 28, 2009

427 N. Yale Avenue
Suite 204
Claremont, CA 91711
Tel: (909) 621-1985
Fax: (909) 624-1664
Email: anselaw@verizon.net



Trademark Opposition 91186018 -- IN-N-OUT BURGERS v. Brian and Sandra Quaglia

Friday, April 10, 2009 8:26 PM

From: "Edward Ansell" <anselaw@verizon.net>

To: "Brian Quaglia" <brianq@whydesign.com>

Bcc: "Arnie M. Wensinger" <AWensinger@innout.com>, "Rachel Blake" <rblake@innout.com>
QUAGLIARULES.pdf (451KB)

Dear Mr.Quaglia:

This is a follow-up to our telephone conversation of Friday, April 10, the purpose of which was to conduct the mandatory Discovery Conference, set forth in the schedule at page 7 of the 12-page Opinion by the Trademark Trial and Appeal Board, mailed on April 3, 2009. The deadline for the Conference was designated as April 11, which is Saturday, and that is why I phoned you on the 10th. This requirement also applies to Sandra Quaglia, the owner of an undivided interest in your trademark application.

Since you said you didn't know what my call was about, I agreed to send you an explanatory email. As more fully set forth in Trademark Rule 2.120(a)(2), a copy of which is attached, the Board Order instituting the Opposition directs the parties to discuss the following topics as part of the Discovery Conference:

1. The nature of and basis for their respective claims and defenses;
2. The possibility of settling the case or at least narrowing the scope of claims or defenses; and
3. Arrangements relating to disclosures, discovery, and introduction of evidence at trial.

Please pass this information on to Sandra Quaglia as I will call again on Monday, April 13. I hope you will find this information helpful.

Sincerely yours,

/Edward O. Ansell/

**In-N-Out Burgers
v.
Brian & Sandra Quaglia
Opposition 91186018
Exhibit A**

CONFIDENTIALITY NOTICE: The information and all attachments contained in this electronic communication are legally privileged and confidential information, subject to the attorney-client privilege and intended only for

the use of the intended recipients. If the reader of this message is not an intended recipient, you are hereby notified that any review, use, dissemination, distribution or copying of this communication is strictly prohibited. If you have received this communication in error, please notify us immediately of the error by return email and please permanently remove any copies of this message from your system and do not retain any copies, whether in electronic or physical form or otherwise.

PATENT AND TRADEMARK CASES -
RULES OF PRACTICE IN TRADEMARK CASES

- (2) The discovery conference shall occur no later than the opening of the discovery period, and the parties must discuss the subjects set forth in Federal Rule of Civil Procedure 26(f) and any subjects set forth in the Board's institution order. A Board Interlocutory Attorney or Administrative Trademark Judge will participate in the conference upon request of any party made after answer but no later than ten days prior to the deadline for the conference. The participating attorney or judge may expand or reduce the number or nature of subjects to be discussed in the conference as may be deemed appropriate. The discovery period will be set for a period of 180 days. Initial disclosures must be made no later than thirty days after the opening of the discovery period. Disclosure of expert testimony must occur in the manner and sequence provided in Federal Rule of Civil Procedure 26(a)(2), unless alternate directions have been provided by the Board in an institution order or any subsequent order resetting disclosure, discovery or trial dates. If the expert is retained after the deadline for disclosure of expert testimony, the party must promptly file a motion for leave to use expert testimony. Upon disclosure by any party of plans to use expert testimony, whether before or after the deadline for disclosing expert testimony, the Board may issue an order regarding expert discovery and/or set a deadline for any other party to disclose plans to use a rebuttal expert. The parties may stipulate to a shortening of the discovery period. The discovery period may be extended upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. If a motion for an extension is denied, the discovery period may remain as originally set or as reset. Disclosure deadlines and obligations may be modified upon written stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. If a stipulation or motion for modification is denied, disclosure deadlines may remain as originally set or reset and obligations may remain unaltered. The parties are not required to prepare or transmit to the Board a written report outlining their discovery conference discussions, unless the parties have agreed to alter disclosure or discovery obligations set forth by these rules or applicable Federal Rules of Civil Procedure, or unless directed to file such a report by a participating Board Interlocutory Attorney or Administrative Trademark Judge.



Re: Trademark Opposition 91186018 -- IN-N-OUT BURGERS v. Brian and Sandra Quaglia

Sunday, April 12, 2009 3:19 PM

From: "brianq@whydesign.com" <brianq@whydesign.com>

To: "Edward Ansell" <anselaw@verizon.net>

I WAS TOLD THAT WE HAD SBMITTED A LETTER TO YOU SOME TIME AGO SAYING WE ARE NOT ARGUING THE POINT.; THIS ITEM WE ARE NOT EVEN PROCEEDING WITH AND HAVE NOT PRODUCED ANYTHING... ITS A DICE GAME. AND IT HAS NEVER BEEN MADE IT WAS ONLY AN IDEA A LONG TIME AGO.

B

On Apr 10, 2009, at 11:26 PM, Edward Ansell wrote:

Dear Mr.Quaglia:

In-N-Out Burgers
v.
Brian & Sandra Quaglia
Opposition 91186018
Exhibit B

This is a follow-up to our telephone conversation of Friday, April 10, the purpose of which was to conduct the mandatory Discovery Conference, set forth in the schedule at page 7 of the 12-page Opinion by the Trademark Trial and Appeal Board, mailed on April 3, 2009. The deadline for the Conference was designated as April 11, which is Saturday, and that is why I phoned you on the 10th. This requirement also applies to Sandra Quaglia, the owner of an undivided interest in your trademark application.

Since you said you didn't know what my call was about, I agreed to send you an explanatory email. As more fully set forth in Trademark Rule 2.120(a)(2), a copy of which is attached, the Board Order instituting the Opposition directs the parties to discuss the following topics as part of the Discovery Conference:

1. The nature of and basis for their respective claims and defenses;
2. The possibility of settling the case or at least narrowing the scope of claims or defenses; and
3. Arrangements relating to disclosures, discovery, and introduction of evidence at trial.

Please pass this information on to Sandra Quaglia as I will call again on Monday, April 13. I hope you will find this information helpful.

Sincerely yours,

/Edward O. Ansell/

CONFIDENTIALITY NOTICE: The information and all attachments contained in this electronic communication are legally privileged and confidential information, subject to the attorney-client privilege and intended only for the use of the intended recipients. If the reader of this message is not an intended recipient, you are hereby notified that any review, use, dissemination, distribution or copying of this communication is strictly prohibited. If you have received this communication in error, please notify us immediately of the error by return email and please permanently remove any copies of this message from your system and do not retain any copies, whether in electronic or physical form or otherwise.

<QUAGLIARULES.pdf>



Re: Trademark Opposition 91186018 -- IN-N-OUT BURGERS v. Brian and Sandra Quaglia

Sunday, April 12, 2009 4:44 PM

From: "Edward Ansell" <anselaw@verizon.net>

To: "brianq@whydesign.com" <brianq@whydesign.com>

Bcc: "Arnie M. Wensinger" <AWensinger@innout.com>, "Rachel Blake" <rblake@innout.com>

Dear Mr. Quaglia:

Unfortunately, I have received no such letter. If you and Sandra Quaglia do not wish to proceed with this Opposition, you must **both** clearly say so, since Ms. Quaglia is the owner of an undivided interest in trademark application 76/687,307 for IN & OUT. Otherwise, we will have to proceed. Please let me know your joint wishes ASAP so I can inform the TTAB.

Sincerely,

/Edward O. Ansell/
Attorney for Opposer

**In-N-Out Burgers
v.
Brian & Sandra Quaglia
Opposition 91186018
Exhibit C**

--- On Sun, 4/12/09, brianq@whydesign.com <brianq@whydesign.com> wrote:

From: brianq@whydesign.com <brianq@whydesign.com>

Subject: Re: Trademark Opposition 91186018 -- IN-N-OUT BURGERS v. Brian and Sandra Quaglia

To: "Edward Ansell" <anselaw@verizon.net>

Date: Sunday, April 12, 2009, 3:19 PM

I WAS TOLD THAT WE HAD SBMITTED A LETTER TO YOU SOME TIME AGO SAYING WE ARE NOT ARGUING THE POINT.; THIS ITEM WE ARE NOT EVEN PROCEEDING WITH AND HAVE NOT PRODUCED ANYTHING... ITS A DICE GAME. AND IT HAS NEVER BEEN MADE IT WAS ONLY AN IDEA A LONG TIME AGO.

B

On Apr 10, 2009, at 11:26 PM, Edward Ansell wrote:

Dear Mr.Quaglia:

This is a follow-up to our telephone conversation of Friday, April 10, the purpose of which was to conduct the mandatory Discovery Conference, set forth in the schedule at page 7 of the 12-page Opinion by the Trademark Trial and Appeal Board, mailed on April 3, 2009. The deadline for the Conference was designated as April 11, which is Saturday, and that is why I phoned you on the 10th. This requirement also applies to Sandra Quaglia, the owner of an undivided interest in your trademark application.

Since you said you didn't know what my call was about, I agreed to send you an explanatory email. As more fully set forth in Trademark Rule 2.120(a) (2), a copy of which is attached, the Board Order instituting the Opposition

directs the parties to discuss the following topics as part of the Discovery Conference:

1. The nature of and basis for their respective claims and defenses;
2. The possibility of settling the case or at least narrowing the scope of claims or defenses; and
3. Arrangements relating to disclosures, discovery, and introduction of evidence at trial.

Please pass this information on to Sandra Quaglia as I will call again on Monday, April 13. I hope you will find this information helpful.

Sincerely yours,

/Edward O. Ansell/

CONFIDENTIALITY NOTICE: The information and all attachments contained in this electronic communication are legally privileged and confidential information, subject to the attorney-client privilege and intended only for the use of the intended recipients. If the reader of this message is not an intended recipient, you are hereby notified that any review, use, dissemination, distribution or copying of this communication is strictly prohibited. If you have received this communication in error, please notify us immediately of the error by return email and please permanently remove any copies of this message from your system and do not retain any copies, whether in electronic or physical form or otherwise.
<QUAGLIARULES.pdf>

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In-N-Out Burgers)	
Opposer)	
)	Application No. 76/687,302
v.)	
)	Filed: March 3, 2008
Brian Quaglia and Sandra Quaglia)	
Applicants)	
)	

FIRST AMENDED NOTICE OF OPPOSITION

Opposer, In-N-Out Burgers, a California Corporation, with a business address of 4199 Campus Drive (10th Floor), Irvine, CA 92612, hereby opposes registration of the mark IN & OUT that is the subject of application 76/687,302, published in the Official Gazette of July 22, 2008 and requests that registration to Applicants be refused.

1. Opposer, for many years and since long prior to any date of first use upon which Applicants can rely, has adopted and continuously uses the term **in-n-out** in connection with retail and mail order merchandise including sporting equipment for a game;
2. Opposer for many years and long prior to any date of first use upon which Applicants can rely, has adopted and continually used the term IN-N-OUT OPOLY for a game, namely, a board game including dice;
3. Opposer is the owner of registration 2,285,823 for the mark **in-n-out** for computer services, namely, providing data bases in the field of restaurant services, and in the field of retail and mail order merchandising services, and said registration is valid, subsisting, unrevoked and uncanceled. A current printout of

information from the electronic database records of the USPTO showing the current status and title of the registration is attached.

4. Opposer, for many years and since long prior to any date of first use upon which Applicants can rely has adopted and continuously used the term IN-N-OUT in connection with its sponsorship of games, namely, golf tournaments to raise money for donation to organizations with the intent to help abused and neglected children.
5. Opposer is the owner of registrations 1,514,689 and 1,960,015 for the mark IN-N-OUT BURGER and design for shirts, baseball caps, letterman's jackets and cook aprons; retail and mail order services featuring watches, novelty jewelry, key rings, drinking utensils, clothing, aprons and sporting equipment, each of which is valid, subsisting, unrevoked, incontestable and uncanceled. A current printout of information from electronic database records of the USPTO showing the current status and title of the registration is attached.
6. Opposer, for many years and since long prior to any date of first use upon which Applicants can rely, has adopted and continuously used the terms IN-N-OUT and IN-N-OUT BURGER in connection with the operation of its restaurant services, including take-out services. Opposer's marks have achieved a high degree of public recognition and renown and have received extensive media attention.
7. Opposer is the owner of the following registrations for the mark IN-N-OUT for restaurant services and carry-out restaurant services, each of said registrations being valid, subsisting, unrevoked and uncanceled: IN-N-OUT--1,085,163; 1,522,799; 1,525,982. A current printout of information from electronic database

records of the USPTO showing the current status and title of the registration is attached.

8. Opposer is the owner of the following registrations for the mark IN-N-OUT for food items associated with its restaurant services, including take-out services, namely cheeseburgers, hamburgers, french fried potatoes, hot coffee, milk, milkshakes, lemonade and soft drinks, each of which is valid, subsisting, unrevoked and uncanceled: IN-N-OUT -- 1,101,628; 1,101,638; 1,522,799; 1,525,982. A current printout of information from electronic database records of the USPTO showing the current status and title of the registration is attached.
9. Opposer is the owner of Registration 2,217,307 for the mark IN-N-OUT for shirts, baseball caps, letterman's jackets and cooks aprons, said registration being valid, subsisting, unrevoked, incontestable and uncanceled. A current printout of information from electronic database records of the USPTO showing the current status and title of the registration is attached.
10. Applicants' mark so resembles Opposer's previously used and registered marks in-n-out, IN-N-OUT and IN-N-OUT BURGER as to be likely, when used in connection with the goods set forth in Applicants' application, to cause confusion, mistake, or deception within the meaning of Section 2(d) of the Lanham Act.
11. Applicants' mark so resembles Opposer's previously used, registered, and famous marks inn-n-out, IN-N-OUT and IN-N-OUT BURGER as to be likely, when used in connection with the goods set forth in Applicants' application, to lessen the capacity of Opposer's said marks to identify and distinguish Opposer's services and goods, regardless of the presence or absence of competition between Opposer

and Applicants, or likelihood of confusion, mistake or deception within the meaning of Section 43(c) of the Lanham Act.

12. Application 76/687,302 for the mark IN & OUT, originally and currently filed on the basis of Section 1(a) of the Trademark Act, is fraudulent inasmuch as the goods set forth in the application's description of goods have not been used "in commerce."

WHEREFORE, Opposer prays that the opposition be sustained and that registration to Applicants be refused.

Respectfully submitted,
In-N-Out Burgers



By /Edward O. Ansell/
Edward O. Ansell
Attorney for Opposer

Date: April 28, 2009

Attachments:

- A. Registration 2,285,823
- B. Registration 1,514,689
- C. Registration 1,960,015
- D. Registration 1,085,163
- E. Registration 1,522,799
- F. Registration 1,525,982
- G. Registration 1,101,628
- H. Registration 1,101,638
- I. Registration 2,217,307

427 N. Yale Ave., #204
P.O. Box 1163
Claremont, CA 91711
Tel: (909) 621-1985
Fax: (909) 624-1664
Email: anselaw@verizon.net

PROOF OF SERVICE:

I hereby certify that on April 28, 2009, a copy of the foregoing First Amended Notice Of Opposition was deposited with the U.S. Postal Service, first class mail postage prepaid, to Applicant, Brian Quaglia, 151 Airport Rd., Warwick, RI 02886.

/Edward O. Ansell/
Edward O. Ansell

PROOF OF SERVICE:

I hereby certify that on April 28, 2009, a copy of the foregoing First Amended Notice Of Opposition was deposited with deposited with the U.S. Postal Service, first class mail postage prepaid, to Applicant Sandra Quaglia, 77 Peck Street, Rehoboth, MA 02769-2806

/Edward O. Ansell/
Edward O. Ansell